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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/842,179	04/26/2001	Ryuichi Suzuki	1506.1007	7275

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EXAMINER

LAZARO, DAVID R

ART UNIT PAPER NUMBER

2155

DATE MAILED: 11/10/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 09/842,179	<b>Applicant(s)</b> SUZUKI ET AL.	
	<b>Examiner</b> David Lazaro	<b>Art Unit</b> 2155	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 29 July 2003.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-5 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-5 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 17 October 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
- 1) ☐ Certified copies of the priority documents have been received.
- 2) ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
- 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)               | Paper No(s)/Mail Date. _____  |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>07/29/03</u> .  | 6) <input type="checkbox"/> Other: _____                                    |

### **DETAILED ACTION**

1. Claims 1-5 are pending in this Office Action.

#### ***Priority***

2. Receipt is acknowledged of papers filed under 35 U.S.C. 119 (a)-(d) based on an application filed in Japan on 04/26/2000. Applicant has not complied with the requirements of 37 CFR 1.63(c), since the oath, declaration or application data sheet does not acknowledge the filing of any foreign application. A new oath, declaration or application data sheet is required in the body of which the present application should be identified by application number and filing date.

#### ***Information Disclosure Statement***

3. The information disclosure statement (IDS) submitted on 07/29/03 has been considered by the examiner. The examiner notes the NPL reference by Bailey, Edward, titled "MAXIMUM RPM" contains only chapters 2, 6, 10, 13, 14 and parts of 21.

#### ***Oath/Declaration***

4. The oath or declaration is defective. A new oath or declaration in compliance with 37 CFR 1.67(a) identifying this application by application number and filing date is required. See MPEP §§ 602.01 and 602.02.

The oath or declaration is defective because:  
It does not identify the foreign application for patent or inventor's certificate on which priority is claimed pursuant to 37 CFR 1.55, and any foreign application

having a filing date before that of the application on which priority is claimed, by specifying the application number, country, day, month and year of its filing.

***Claim Objections***

5. Claim 1 is objected to because of the following informalities:

- a. In line 15, "an" should be "a".
- b. In line 20, "Each of said client apparatus" should be "each of said one or more client apparatuses" for consistency and clarity.

Appropriate correction is required.

6. Claim 2 is objected to because of the following informalities:

- c. In the last line, "therebetween" is not a recognized English word (is not defined in a standard English dictionary).

Appropriate correction is required.

7. Claim 5 is objected to because of the following informalities:

- d. In lines 1-2, "consists of plural files for adding ability to perform specific processing to" would be clearer as "consists of a plurality of files for adding the ability to perform specific processing, to".
- e. In line 3, "communicating a server apparatus" would be clearer as "communicating with a server apparatus".
- f. In line 7, "by user" should be "by a user".

- g. In line 15, "starts the specific processing with using" would be clearer as "start the specific processing using".

Appropriate correction is required.

***Claim Rejections - 35 USC § 101***

8. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

9. Claim 5 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Claim 5 describes a computer-executable program product for adding to a computer communicating with a server, the ability to perform specific processing based on the latest version of files, if available, that are related to the specific processing. However, descriptions and expressions of a computer-executable program product not encoded on a computer readable medium do not define any structural and functional interrelationships between the computer program and other claimed elements of a computer which permit the computer program's functionality to be realized (See MPEP 2106.IV.B.1(a)). Therefore Claims 5 is directed to non-statutory subject matter.

***Claim Rejections - 35 USC § 102***

10. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

11. Claims 1-5 are rejected under 35 U.S.C. 102(e) as being anticipated by U.S.

Patent 6,006,034 by Heath et al. (Heath).

12. With respect to Claim 1, Heath teaches a client-server system including a server apparatus and one or more client apparatuses (Col. 1 lines 6-27 and Fig. 2b), said server apparatus comprising: a server side file storing part for storing one or more files which are to be stored in a client apparatus to perform specific processing (Col. 1 line 56 - Col. 2 line 5); an update list storing part for storing a update list holding information which specifies versions of the one or more files stored in said server side file storing part (Col. 4 line 59 - Col. 5 line 13); an update list sending back part for, when a processing start request of fixed contents is received, sending back the update list stored in said update list storing part to the client apparatus from which the processing start request is sent (Col. 5 lines 31-40); and an sending back part for, when receiving a transfer request for one or more files stored in said server side file storing part, sending back the one or more files requested by the transfer request in said server side file storing part to the client apparatus from which the transfer request is sent (Col. 5 lines 55-67); Each of said client apparatus comprising a client side file storing part for storing one or more files used to perform the specific processing (Col. 1 line 56 - Col. 2 line 5); a local update list storing part for storing a local update list holding information which specifies versions of the one or more files stored in said client side file storing part (Col.

5 lines 41-54); a processing start request sending part for sending the processing start request, when instruction to start the specific processing is given by user (Col. 5 lines 31-40); a file specifying part for specifying one or more files to obtain for performing the specific processing in the latest condition by comparing the local update list stored in the local update list storing part with the update list received in response to the start request sent by said processing start part (Col. 5 lines 41-67); and a specific processing starting part for, if one or more files are specified by said file specifying part, sending the transfer request for the specified files to said server apparatus and storing the one or more files which said sending back part of said server apparatus sends in response to the transfer request into said client side file storing part and updating the local update list in said local update list storing part according to the stored files and starting the specific processing, and for, if no file is specified by said file specifying part, starting the specific processing (Col. 5 lines 41-67).

13. With respect to Claim 2, Heath teaches all the limitations of Claim 1 and further teaches wherein the specific process is a process that said server apparatus and said client apparatus performs while exchanging information therebetween (Col. 2 line 63 - Col. 3 line 6).

14. With respect to Claim 3, Heath teaches all the limitations of Claim 1 and further teaches wherein said server apparatus further comprises software supplying part for supplying software which causes a computer capable of communicating with said server apparatus to function as said client apparatus (Col. 8 lines 27-44).

15. With respect to Claim 4, Heath teaches a computer readable medium stored with software for causing a computer capable of communicating with a server apparatus to function as a client apparatus (Col. 1 line 56 - Col. 2 line 5), said server apparatus comprising: a server side file storing part for storing one or more files which are to be stored in a client apparatus to perform specific processing (Col. 1 line 56 - Col. 2 line 5); an update list storing part for storing a update list holding information which specifies versions of the one or more files stored in said server side file storing part (Col. 4 line 59 - Col. 5 line 13); an update list sending back part for, when a processing start request of fixed contents is received, sending back the update list stored in said update list storing part to the client apparatus from which the processing start request is sent (Col. 5 lines 31-40); and an sending back part for, when receiving a transfer request for one or more files stored in said server side file storing part, sending back the one or more files requested by the transfer request in said server side file storing part to the client apparatus from which the transfer request is sent (Col. 5 lines 55-67); said client apparatus comprising: a client side file storing part for storing one or more files used to perform the specific processing (Col. 1 line 56 - Col. 2 line 5); a local update list storing part for storing a local update list holding information which specifies versions of the one or more files stored in said client side file storing part (Col. 5 lines 41-54); a processing start request sending part for sending the processing start request, when instruction to start the specific processing is given by user (Col. 5 lines 31-40); a file specifying part for specifying one or more files to obtain for performing the specific processing in the latest condition by comparing the local update list stored in the local update list storing



part with the update list received in response to the start request sent by said processing start part (Col. 5 lines 41-67); and a specific processing starting part for, if one or more files are specified by said file specifying part, sending the transfer request for the specified files to said server apparatus and storing the one or more files which said sending back part of said server apparatus sends in response to the transfer request into said client side file storing part and updating the local update list in said local update list storing part according to the stored files and starting the specific processing, and for, if no file is specified by said file specifying part, starting the specific processing (Col. 5 lines 41-67).

16. With respect to Claim 5, Heath teaches a computer-executable program product consists of plural files for adding ability to perform specific processing to a computer capable of communicating a server apparatus (Col. 1 lines 6-27 and line 56 - Col. 2 line 5), said computer-executable program product including: computer readable program code to send a processing start request to the server apparatus, when instruction to start the specific processing is given by user (Col. 5 lines 31-40); and computer readable program code to receive, as a response to the start request, information about versions of files provided in the server apparatus (Col. 5 lines 31-54) and specifies one or more files to be downloaded for performing the specific processing in the latest condition based on the received information (Col. 5 lines 41-67); and computer readable program code to, if one or more files are specified, download the specified files from the server apparatus and then starts the specific processing with using the downloaded

files, and, if no file is specified, starts the specific processing without downloading any file from the server apparatus (Col. 5 lines 55-67).

### ***Conclusion***

17. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

18. U.S. Patent 5,491,820 by Belove et al. "Distributed, intermittently connected, object oriented database and management system" February 13, 1996. Discloses uses of a locally stored client list that is transmitted to the server to request an update of the data items listed and stored on the client.

19. U.S. Patent 5,752,042 by Cole et al. "Server computer for selecting program updates for a client computer based on results of recognizer program(s) furnished to the client computer" May 12, 1998. Discloses the use of a program sent to the client by the server to determine if the client requires code updates.

20. U.S. Patent 6,282,711 by Halpern et al. "Method for more efficiently installing software components from a remote server source" August 28, 2001. Discloses the use of client server dialog to determine what software components and options are needed by the client for installation of a application.


21. U.S. Patent 6,493,871 by McGuire et al. "Method and system for downloading updates for software installation" December 10, 2002. Discloses the use of a server list

of files required compared to a client list of files to determine what files need to be updated or installed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David Lazaro whose telephone number is 571-272-3986. The examiner can normally be reached on 8:30-5:00 M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Hosain Alam can be reached on 571-272-3978. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
David Lazaro  
November 3, 2004

  
**HOSAIN ALAM**  
SUPERVISORY PATENT EXAMINER